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IN THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE NINTH CIRCUIT.

No. 10,045.

GRAYSON HEAT CONTROL, LTD.,
Plaintiff-Appellant,
vs.

LOS ANGELES GAS APPLIANCE CO., INC.,
Defendant-Appellee.

PLAINTIFF-APPELLANT'S REPLY BRIEF.

ERROL O. SHOUR,
IRA J. WILSON,
Attorneys for Plaintiff-Appellant.

Eastman Bros., Law Printers, 542 S. Dearborn St., Chicago.

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**RE GRAYSON PATENT 1,699,468 (R. 632) CLAIMS 20
AND 22 IN SUIT.**

The Defense of New Matter and Lack of Oath.

Defendant's brief, pages 7-17, seeks to support Judge Jenney's holding of invalidity of claims 20 and 22, which was based on the erroneous belief that freedom for radial expansion of Grayson's clicker disc constituted a mechanical element of these claims and that this feature constituted new matter unsupported by oath.

In its brief opposite page 13, defendant has presented a tabular comparison between claims 20 and 22 in suit and

rejected and cancelled claim 21. Such a chart might be pertinent to a question of infringement, since it is axiomatic that a patent claim containing a specific limitation not included in a cancelled claim cannot be construed so as to disregard such limitation. Defendant nowhere argues, however, that the limitations appearing in the fourth and fifth columns of its chart are not found in defendant's structure. The chart has no pertinency regarding infringement.

Invalidity on the ground of new matter or lack of oath obviously cannot be established or affected by any comparison of the claims in suit with any claim presented by amendment simultaneously with the claims in suit.

Appellee's chart is not devoted to non-infringement, and establishes nothing respecting the alleged newness of the segregated matter. Irrespective of its charm, it has no utility in this case.

Apparently appellee desires this Court to believe that the patentable novelty in claims 20 and 22 resides in the radial expansion of the disc. Two reasons refute this fallacy:

(1) The distinction between the claims in suit and cancelled claim 21 resides in the mechanical mounting of the disc, that is, in its loose support which permits radial expansion, and not in the radial expansion itself which is merely a function or result of such loose support.

(2) Patentability of a combination does not depend upon the novelty of any element. The invention of a combination claim resides in that combination which, if novel, produces a new result or an old result in a better or more facile manner, and the elements of which the combination consists may be all old or all new or partly old and partly new.

Elaborating upon reason (1), it has been shown in plaintiff's main brief, pp. 17-20, that the Grayson application as originally filed described the diaphragm or clicker disc as being "comparatively loose . . . the extreme edge being free" and "may snap over" (R. 689). Again, the original application stated that the supporting means for the disc "leaves the edge of the disc comparatively loose and free" (R. 691). And again, the disc was described as "resting freely at its edge on said shoulder" (R. 637). The loose mounting of the disc was unquestionably disclosed in the Grayson application as originally sworn to and filed.

In the trial of this case, a disc thus loosely mounted was repeatedly referred to as a "full floating" disc. A full floating clicker disc was defined as:

"a clicker disc which is dropped into the assembly, without any clamping around the periphery or at the center. It means a clicker disc so mounted that when we attempt to crowd the metal through, as we must do in getting a clicker action, the metal has to go somewhere, we have it free to expand toward the outside, and that cuts the forces down to something like one-fifth of what they are in the anchored type." (R. 189.)

That a disc thus loosely supported is inherently free to expand radially was repeatedly recognized by the experts for both parties in this case. Plaintiff's expert, Mr. Fishleigh, in referring to the Grayson disc said in referring to it as full floating:

"By that I mean a disc which is supported, as explained in the patent, so that it is loosely supported around its periphery and in no way anchored or clamped; and therefore, being free to expand radially as we attempt to snap it by center." (R. 217.)

In referring to the Spencer patent 1,678,407 in which the disc is clamped around the margins of the center opening, Mr. Fishleigh said that this was not a full floating clicker disc

“and is not capable of full radial expansion in the sense of both the patents in suit and the defendant’s disc. It is restricted at the center, a substantial restriction, so that the forces required to click it past center are large compared to what the Grayson two patents show, or like the defendant’s structure, and I know that from tests I have run.” (R. 291.)

Likewise, defendant’s expert, Mr. Weinberg, recognized that a disc loosely supported at its marginal edge is inherently capable of radial expansion. Referring to Spencer patent 1,681,911, in which he said the disc was “loosely supported at its marginal edge,” he, on direct examination regarding this disc, testified:

“Q. And is that disc free to expand to whatever extent there may be radial expansion in the disc?

“A. Yes, in so far as its support is concerned.” (R. 454.)

Again, referring to Spencer patent 1,678,407 which discloses a clicker disc having the edges unconfined, Mr. Weinberg testified on direct examination:

“Q. Do you find that the outer marginal edge of the disc 15 is free so that radial expansion of said disc under pressure is permitted?

“A. Yes.” (R. 464.)

Again, in comparing the Grayson disc 30, defendant’s disc 4, and the disc 15 of Spencer patent 1,678,407, Weinberg testified:

“Each of the snap-action devices are further similar in that they are allegedly free to expand radially or diametrically. The peripheral edge 4a of the accused snap ring and the peripheral edge 15a of the Spencer device are both supported without contact with a surrounding or supporting structure, whereby at least, in so far as their support is concerned, the same are free to expand diametrically.” (R. 490.)

Again, regarding the Grayson disc, Weinberg testified:

“I measured the expansion of the Grayson snap

disc, and found that the diametrical expansion of that disc was between one and two-thousandths of an inch.” (R. 512.)

The experts are agreed, no one disputes, and everyone knows that a clicker disc loosely supported with its edges free to snap over when pressure is applied to the disc is inherently capable of radial expansion and does radially expand when snapped over. If the disc be confined around its perimeter, it cannot expand radially. It is the mounting which determines whether or not the disc can expand and it is the mounting, that is, the mechanical support for the disc, which distinguishes the claims in suit from cancelled claim 21.

When a disc is loosely mounted with its peripheral edges unconfined, as it is in plaintiff’s and defendant’s structures, only one-fifth the force is required to snap it over as is required when the edges are clamped or confined (R. 189 and 588-591).

When a disc is thus loosely mounted, it is *ipso facto* and inherently free for radial expansion. The loose mounting necessarily permits radial expansion. Radial expansion requires a loose mounting. The loose mounting, not the radial expansion, is the structural feature of the claims in question.

Claim 20 specifies that the disc is “mounted in said body so that the marginal edge thereof is loosely supported.” Incidentally it adds that the radial expansion of the disc under pressure is permitted.

Claim 22 specifies that the disc is “*mounted* so as to be free to expand radially when pressure is applied thereto.” (Emphasis ours.) A disc mounted in this manner is of necessity loosely mounted, or it would not be free to expand radially. In this claim also it is the *mounting*, that is, the structural support for the disc, that differs over rejected claim 21.

When Grayson amended his application which *ab initio* disclosed and described a disc loosely supported, he merely explained why a statement in his original specification that

“if a diaphragm as small in diameter . . . were clamped at the edge, it could have no snap action”

was true. The explanation added was

“because radial expansion of the disk under pressure would not be permitted in such a construction.”

By this amendment Grayson merely elucidated a scientific principle of his invention. He explained an added advantage of the structure originally disclosed, and referred to the characteristic of radial expansion inherent in the loosely supported disc originally disclosed. This explanation was not new matter. (See authorities under Points 5, 6 and 7 of plaintiff-appellant's main brief.)

Referring to reason (2) above noted, that the patentability of a combination claim does not depend upon the novelty of any element, the rule is well stated in *Leeds & Catlin Co. v. Victor Talking Mach. Co.*, 213 U. S. 325, 53 L. Ed. 816:

“A combination is a composition of elements, some of which may be old and others new, or all old or all new. It is, however, the combination that is the invention, and is as much a unit in contemplation of law as a single or noncomposite instrument. Whoever uses it without permission is an infringer of it. Whoever contributes to such use is an infringer of it.”

In *Heim Grinder Co. v. Fafnir Bearing Co.*, 13 F. (2d) 408, the doctrine was recognized in the following language:

“If a claim covers a true combination, the novelty of the elements severally, is a moot question.”

It is manifest, therefore, that the patentability of claims 20 and 22 does not depend upon the novelty of the loosely supported disc by which they differ from cancelled claim 21, but depends upon the novelty of the combination in-

cluding this loose support which resulted in the undisputed advantages set forth in the testimony and succinctly stated at pages 61-63 of the record.

It is also manifest that the loosely supported disc disclosed in the Grayson application as originally filed was inherently capable of radial expansion, and that when such disclosure was made the public needed only to follow such disclosure and loosely support the disc to obtain all of the advantages and functions of the device. The explanation,

“because radial expansion of the disc under pressure would not be permitted in such a construction”

added by amendment to the original statement:

“if a diaphragm as small in diameter as the present one were clamped at the edge, it could have no snap action”

was not a disclosure of a new structure or a new principle or mode of operation. It merely explained why the originally disclosed structure could be operated with so little pressure and consequently possessed such high sensitivity. In no sense of the patent law was it new matter.

Cases Relied Upon by Appellee Distinguished from the Facts Here Presented.

While the selected language quoted from decisions relied upon by defendant seems on its face to be pertinent, an examination of the cases discloses facts quite foreign to and readily distinguishable in principle from those here presented.

In *Standard Oil Development Co. v. Berry*, 92 F. (2d) 386, the facts, not set forth in this decision but ascertainable from the trial court's decision, 14 F. Supp. 881, show that in that case the original application disclosed the em-

ployment of steam for heating purposes but not for stripping the descending liquids in the tower. The stripping claims sued upon were derived by consent from another patent where they were based upon a substantially different disclosure from that of the application to which they were transferred.

In *Simpson v. Newport News Ship Building and Dry Dock Co.*, 18 F. (2d) 318, the original application failed to claim, as did also the corresponding British patent, the hatch coamings or the hanging therefrom. Subsequently the claims in suit, directed to entirely different subject matter than originally claimed in specifying that the tank was hung from the hatch coaming, were inserted by amendment without oath. This is the type of case in which matter originally disclosed but not claimed under the original oath is required to be supported, if later claimed, by a supplemental oath under the provisions of Rule 48, which reads:

“When an applicant presents a claim for matter originally shown or described but not substantially embraced in the statement of invention or claim originally presented, he shall file a supplemental oath to the effect that the subject matter of the proposed amendment was part of his invention,” etc.

This rule is based on Revised Statutes, Sec. 4892, U. S. Code Title 35, Sec. 35.

No such requirement for new oath is presented in the present case, because the loosely supported disc was claimed in the Grayson application as originally filed. The later added explanation that such loosely supported disc expanded radially when snapped over introduced no structure not originally claimed as a loosely supported disc.

In *Steward v. American Lava Co.*, 215 U. S. 161, 54 L. Ed. 139, the original specification and claims claiming a burner were cancelled and a complete new specification and

claims claiming a process were substituted by the attorney without the inventor's oath. The alleged process was based upon a theory of operation not suggested in the original application.

On page 14 of its brief defendant emphasizes this case, and says that in the Grayson application for the patent in suit "there was introduced not merely the theory, but the mode of applying it, into the specification by an unverified amendment."

Defendant disregards the recognition in the *American Lava Co.* case by the court that:

"A mechanical device will be patentable although the true theory of it is not understood."

This is the pertinent language of this case to the Grayson patent in suit. Grayson disclosed and claimed in his original application a loosely supported disc. From this disclosure the public was taught how to manufacture and use the Grayson thermostat. Whether the public or whether even Grayson knew that such loosely supported disc would expand readily when snapped over was entirely immaterial. The disclosure of the employment of the loosely mounted disc in the novel combination claimed constituted an adequate legal basis for the issuance of the patent. Grayson's amendment introduced no new theory into the case, but simply explained why the loosely mounted disc would snap over easily under light pressure. The doctrine of the *American Lava* case is not applicable in the slightest degree.

The remaining cases quoted from by defendant are even less pertinent than those above discussed, and the selected language based on facts entirely different from those here presented cannot be utilized to militate against the validity of the Grayson patent.

There Is No File Wrapper Estoppel Against Claims 20 and 22.

On page 17 of its brief defendant argues that if freedom for radial expansion is merely a functional statement, then claims 20 and 22 are unpatentable because a function is not subject matter for a patent. Defendant, like Judge Jenney, is confused concerning what is covered by these claims. It is the structural mounting of the disc, that is, the mounting so that the marginal edge is loosely supported, which is claimed. Since freedom for radial expansion is inherent in a disc thus loosely supported and is impossible in a disc confined around its periphery, it is immaterial whether we say the disc is mounted so that it is loosely supported or whether we say it is mounted so as to be free to expand radially. It is the mounting that is important. A mounting which loosely supports the disc affords freedom for radial expansion and a mounting which permits the disc to expand radially must of necessity support the disc loosely.

This mounting is what permits the novel combination defined by the claims to operate in the novel manner and give the advantageous results so clearly set forth in the record of this case and evidenced by the commercial success of the Grayson thermostat. The patentability is in the combination, not in any particular element thereof. Freedom for radial expansion of the disc is an inherent characteristic of the loose mounting which is claimed. There is no file wrapper estoppel against the validity of these claims.

On pages 18 and 19 of its brief, defendant appears to be again confused in attempting to apply the law of file wrapper estoppel respecting infringement to the question of invention or patentability. We are in entire accord with

the doctrine that a claim distinguishing from a cancelled claim by a limitation cannot be stretched by construction to bring within its scope a structure not containing that limitation. The doctrine, however, has no pertinency here, because defendant does not contend that its disc is not mounted so as to be loosely supported and consequently free for radial expansion.

Claims 20 and 22 and the Prior Art.

Appellee's brief, pages 23-34, is devoted to alleged invalidity of claims 20 and 22 of Grayson patent 1,699,468 over the prior art.

In connection with the question of validity, attention is first directed to the authorities pertinent here listed under Points 10, 11 and 12 of appellant's Points and Authorities appearing on page 8 of appellant's main brief.

Attention is further directed to the fact that claims 20 and 22 here in suit were held valid and infringed in a previous suit in the Southern District of California entitled *Grayson Heat Control, Inc., v. E. R. Parker et al.*, Equity No. R-117-M. The decree in that suit appears herein as Exhibit 4, R. 650.

Appellee here urges four prior art patents which will now be briefly discussed.

MERRICK PATENT 1,542,712 (R. 884).

Respecting this patent Judge Jenney stated:

"The master found, and the court agrees, that the prior patent to Merrick, No. 1,542,712, . . . is the closest reference." (R. 59.)

The Merrick patent was a file reference cited by the Patent Office against the Grayson application, and the claims in suit as well as others were allowed over it.

The Merrick valve does not embody the single axis symmetrical force application principal of Grayson, but, on the contrary, Merrick's thermostat rod 15 is offset laterally from the axis of the spring diaphragm 29 and a fulcrumed lever, a post and a resilient pusher member are interposed between the thermostat rod and the diaphragm to amplify, as well as transmit to the diaphragm, the motion of the thermostat rod. This structure, because of the leverage involved, produces strains, friction and wear upon the lever fulcrum and moving parts, diminishes the sensitivity of the device and results in inaccuracy of functioning.

Merrick does not have the full floating clicker disk of Grayson, but, on the contrary, employs a cup shaped spring diaphragm rigidly anchored around its perimeter and clamped between opposed sections of the valve casing. The diaphragm is not loosely, but rigidly, supported and is not free for radial expansion, but is confined against and precluded from, radial expansion.

The very essence of the Grayson principal, including the single axis symmetrical application of force principal, and the full floating clicker disk, free for radial expansion, which enables snap-over to be accomplished with one-fifth of the force required to snap over a confined disk restrained against radial expansion, is totally absent from the Merrick disclosure.

A graphic comparison between the mechanical elements defined by claims 20 and 22 of the first Grayson patent and the structure of the Merrick patent is made in the Fishleigh chart, Plaintiff's Exhibit 30, from which it will be apparent that Merrick fails as anticipatory of claim 20 in that Merrick's diaphragm is not "mounted in said body so that the marginal edge thereof is loosely supported and radial expansion of said disk is permitted," and the "resilient push disk 30" of Merrick's does not meet the re-

quirements of the claim for a plunger “bearing on one side on the convex side of said disk near the edge thereof, and on the other side in operative relation with the thermostat.” Merrick’s resilient push disk is not in operative relation or engagement in the sense of the Grayson patent with the thermostat but the lever 19 and the post 32 are interposed between the thermostat and the push disk. The post 32 of Merrick, not the thermostat, is in the operative relation to the push disk 30 that Grayson’s thermostat rod is to his plunger.

Similarly, Merrick fails to anticipate claim 22, which requires that the disk be “of small diameter but mounted so as to be free to expand radially when pressure is applied thereto.” Merrick’s diaphragm is neither of small diameter nor is it mounted so as to be free to expand radially.

Like claim 20, claim 22 also requires that the plunger bear at one side on the disk and on the other side in direct operative relation with the thermostat. This direct relation required by the claim is not fulfilled by the indirect relation between the thermostat rod and the push disk 30 of Merrick, which involves the objectionable offset lever mechanism common to the prior art, and the elimination of which is one of the advantageous features of the Grayson invention.

Regarding the tests made by defendant’s expert and referred to on page 31 of appellee’s brief, the Court’s attention is directed to a complete refutation of these tests appearing in the record on pages 585-593. This testimony shows that Weinberg’s tests were valueless and the alleged results thereof were misleading. This testimony further conclusively shows that a loosely supported disc unconfined around its perimeter requires only one-fifth the force to snap it over that is required by a clamped disc such as Merrick’s.

It is manifest, therefore, that the patent office, the Master and the Court in the prior suit upon the Grayson patent, and the Master and the Court in the present case were all correct in unanimously holding that the Merrick patent does not anticipate the claims here in suit of the first Grayson patent.

EGGLESTON PATENT 1,541,929 (R. 996).

This patent was not pleaded nor was notice of it given prior to the trial. It cannot, therefore, be used for anticipatory purposes, but merely as illustrative of the art.

The Eggleston patent discloses a thermostatic air valve, comprising a sylphon bellows containing a volatile liquid. The outer end 16 of the bellows carrying the valve 13 adapted to close against the seat 14 is made of spring material so that under internal pressure this end is convexed outwardly, as shown in Fig. 1, and under vacuum it is convexed inwardly, as shown in Fig. 7. This end, however, is fixedly connected and sealed around its perimeter to the surrounding wall of the bellows. It is not loosely mounted and is not free for radial expansion, but its reversal from convex to concave form is accomplished by an undulatory movement of the disk, like the spring diaphragm of the Merrick patent, previously discussed. This action is similar to that of the bottom of an oil can which can be pressed over center, but the amount of force required to press such a peripherally anchored diaphragm over center is five times that required to actuate a full floating disk free for radial expansion, of the type employed by Grayson (R. 164).

In Eggleston the end 16 is a part of the thermostat itself. Eggleston has no thermostat independent of the end 16; he has no full floating clicker disk, he has no plunger acting directly between a thermostat and a radially

expansible disk, as required by claims 20 and 22, here in issue. Eggleston does not negative invention in the structure defined by claims 20 and 22 of the first Grayson patent.

SPENCER PATENT 1,681,911 (R. 1004).

This patent, like the Eggleston patent above discussed, was not pleaded nor was notice of it given prior to its presentation at the trial before the Master. It can only be considered as illustrative of the art, and cannot be used for anticipatory purposes.

In this Spencer patent the disc itself is the thermostat which actuates the valve 20. This device is quite different in structure and principle of operation from the Grayson combination in which a rod and tube thermostat projecting into a water storage tank, moves a plunger to symmetrically transmit force to a coaxially disposed full floating clicker disk, free for radial expansion, and which is caused by the plunger to snap over into reverse position, thereby actuating a valve.

Spencer employs a bi-metallic thermostatic disk as the thermostat for initiating movement. Grayson employs a full floating clicker disk for converting the motion directly and coaxially transmitted to it from a thermostat, into a snap-action movement, which actuates a valve. The Grayson combination, defined in claims 20 and 22, is entirely absent from the disclosure of this Spencer patent.

SPENCER PATENT 1,678,407 (R. 894).

This patent discloses an electric switch embodying a rod and tube thermostat to the rod of which is anchored a clicker disk which serves when in one position as an electrical conductor to close the circuit and when in reverse position to open the circuit.

In the Grayson patented device when the thermostat is hot, the valve is closed. In the Spencer switch when the thermostat is hot, the circuit is open (R. 378). The Spencer device is not a device of the character described in the Grayson patent, *i.e.*, a thermostatically operated valve, but is a switch.

The Spencer patent does not disclose "a main body" in the sense of the Grayson patent. This is admitted by defendant's expert (R. 553, 572).

The Spencer patent does not disclose "any member adapted to be thermostatically operated" in the sense that this language is used in the Grayson patent (Weinberg R. 568).

Since Spencer has no member corresponding to Grayson's valve member, it has, consequently, no "means for transmitting motion from said thermostat to said member."

Having no such member, Spencer has no spring action disk mounted in a body with a normally concave side toward such a member.

Furthermore, Spencer has no "plunger" in the sense of Grayson.

Defendant's expert on direct examination attempted to argue that the rod 13 of Spencer was a plunger, but on cross he stated:

"Q. Then it is your opinion that the rod 13 is the plunger, is it?

"A. I am afraid not." (R. 570.)

Referring to Spencer, defendant's witness Jenkins admitted concerning the top nut 16, "It is not a plunger." (R. 379.)

"Q. Spencer does not disclose any valve?

"A. No.

"Q. He does not disclose the spring for operating the valve?

“A. No.

“Q. He does not disclose any flange or other means between the disk and a valve for operating it?

“A. No.” (R. 381.)

The Spencer patent obviously does not anticipate or invalidate in any sense either of the claims in suit of the Grayson patent. In addition to defendant's admissions to that effect to which references in the record are made above, attention is called to the substance of Mr. Fishleigh's testimony on this point which is graphically summed up in plaintiff's chart (Ex. 30).

A Selection from Different Places in the Prior Art of Individually Old Elements Does Not Defeat a Combination Claim.

Appellee has presented four prior art patents purporting to disclose various elements of the Grayson combination defined by the claims in suit. No attempt, however, has been made to show that these various elements could be assembled to produce an operative device in anticipation of the Grayson combination. None of these patents discloses a loosely mounted clicker disc interposed between a valve and a thermostat and arranged coaxially with the thermostat and directly actuated thereby without the interposition of levers so as to be snapped over by the thermostat to magnify the movement of the thermostat and transmit such magnified movement to the valve.

A patent for a combination accomplishing, as here, a new and useful result is not anticipated, because the parts of the combination may be individually old.

The Telephone Cases, 126 U. S. 1, 31 L. Ed. 863.

Hobbs v. Beach, 180 U. S. 383, 45 L. Ed. 586.

Chicago Lock Co. v. Tratsch et al., 72 F. (2d) 482, 487 (C. C. A. 7).

Adam v. Folger, 120 F. 260, 262 (C. C. A. 7).

“Where the thing patented is an entirety, consisting of a single device or combination of old elements, incapable of division or separate use, the respondent cannot escape the charge of infringement by alleging or proving that a part of the entire thing is found in one prior patent or printed publication or machine, and another part in another prior exhibit, and still another part in the third one, and from the three or greater number of such exhibits draw the conclusion that the patentee is not the original and first inventor of the patented improvement.”

Bates v. Coe, 98 U. S. 31, 25 L. Ed. 68.

This doctrine has been consistently followed. See

Imhaeuser v. Buerk, 101 U. S. 647, 25 L. Ed. 945.

Adams v. Bellaire Stamping Co., 141 U. S. 539, 35 L. Ed. 849.

Parks v. Booth, 102 U. S. 96, 26 L. Ed. 54.

Seabury v. Am Ende, 152 U. S. 561, 38 L. Ed. 553.

Respecting the Alleged Functionality of Claims 20 and 22 of Patent 1,699,468.

On pages 34 to 36 of its brief appellee repeats its contention discussed *supra* that the functional radial expansion of the disc constitutes the only novelty of the claims and that they are void for functionality.

This contention is fallacious for two reasons:

(1) It is the structural mounting of the disc, and not its function of radial expansion resulting from the mounting, that is defined in the claims.

(2) The patentable novelty resides in the combination of elements defined by the claims, and not in any single element.

Respecting Infringement of Claims 20 and 22.

The only point of noninfringement that defendant attempts to argue in its brief is that defendant's structure does not embody the "plunger" included in claims 20 and 22. Defendant bases this argument upon the unsupported assertion that the flexible levers against which the outer margin of the concave face of defendant's disc rests "*may be considered as the plunger.*" (Italics ours.)

It is manifest without argument that the plunger 5 (Exhibit 1) which defendant prefers to call a "hub" is the plunger of these claims. A few excerpts from the record will show that defendant's contention is utterly unsustainable.

Previously to the filing of appellee's brief, no contention was ever advanced in this case that defendant's flexible levers *may be considered* as the plunger. Only one witness in the entire case had the temerity to suggest that the element 5 (Exhibit 1) was not a plunger. This witness was defendant's expert Weinberg, who thought that an element could not be a plunger unless it was surrounded and slidingly engaged in a cylinder:

"Q. With reference to the plunger, I understand it to be your opinion that defendant does not employ a plunger because the member 5 is not surrounded—slidingly engaged in a cylinder, is that correct?

"A. Yes, sir." (R. 573.)

Defendant's other witness who testified on this point, Mr. Jenkins, the president of the concern that manufactures defendant's infringing thermostats, did not question that the element 5 (Exhibit 1) was a plunger:

"Q. In the accused device the disc is mounted right on the plunger?

"A. That is right." (R. 358.)

In discussing Defendant's Exhibit E, which is an en-

largement of Exhibit 1, and Exhibit O, which was a drawing of a theoretical construction concocted by defendant, Mr. Jenkins said:

“Q. By Mr. Wilson: The operation of the hub or snap ring hub in Exhibit E, and the operation of the plunger in Exhibit O, upon the amplifying levers, is the same in both cases?

“A. On the amplifying element they are the same in both cases.

“Q. So the only difference between these two is that you carry the disc or snap ring on the plunger in Exhibit E, and you carry it on a separate member rigid with the casing in Exhibit O?

“A. Yes, or in other words, we can say in Exhibit E it is a combination hub which supports the ring, and adds amplification to the amplifying element. In Exhibit O it adds amplifications to the levers, and is not a support for the snap ring.

“Q. The functions the two devices perform are the same, except that in the accused device the plunger performs also the function of supporting the disc?

“A. Yes.

“Q. I think you have already testified that the operation and results are the same.

“A. Substantially the same.

“Q. One is the equivalent of the other?

“A. Yes.” (R. 370.)

There was no doubt in the mind of plaintiff's witness Mr. Fishleigh regarding defendant's plunger. In referring to the structure of the Grayson patent as compared with the accused device, Mr. Fishleigh testified:

“In either case, however, what we get is this: We get the force and the movement of the thermostat applied to a plunger and from the plunger to the clicker disc, in either case getting both clicker action and amplified movement; and that is all there is to the whole proposition of using the clicker combination and it is one of mechanical equivalency.” (R. 272.)

Master Head, before whom this case was tried, in describing in his report defendant's accused device, said:

“A hub or plunger 5 supports an annular snap ring 4.” (R. 38.)

In amplification of his views on this point, the Master in his report further stated:

“The term ‘plunger’ as used in the specifications and claims of the patent must be considered in the sense in which the patentee used it. ‘The question is not one of nomenclature but of mechanics.’ *Carlson Motor etc. Company v. Maxwell Briscoe Company*, 197 F. 309 at 315. Defendant attempts to define the term as synonymous with piston. A piston is a plunger but also the dasher of the old fashioned churn can be defined likewise. In the Grayson structure the plunger is guided by a cylindrical bore in the body. In the defendant’s device the corresponding part is unsupported at this point but is pinned to the thermostatic rod. The function of both is to apply the movement of the rod to the disk. They are clearly mechanical equivalents.” (R. 41.)

Judge Jenney in his opinion in describing defendant’s device, stated:

“A hub or plunger 5 supports an annular snap ring 4.” (R. 59.)

In Finding of Fact No. (12), Judge Jenney found as follows:

“The Defendant’s alleged infringing device, as depicted by Plaintiff’s Exhibit 24, reference being had to Figure 1 thereof, operates on the same general principles as the Grayson thermostats. A hub or plunger 5 supports an annular snap ring 4. Ring 4 is a clicker disk, which is capable of being snapped over center, returning through its own resiliency.” (R. 76.)

In view of this record appellee’s half-hearted suggestion in its brief that the flexible levers in defendant’s structure “may be considered as the plunger” merits scarcely momentary consideration.

The rule to be followed here has been well stated by this Court of Appeals in the following cases:

“Defendants therefore cannot escape infringement by adding to or taking from the patented device by changing its form, or even by making it somewhat more or less efficient, while they retain its principle and mode of operation and attain its results by the use of the same or equivalent mechanical means. *Lourie v. Lenhart*, 130 F. 122, 64 C. C. A. 456; *Letson v. Alaska Packers Association*, 130 F. 129, 64 C. C. A. 463; *Eck v. Kutz* (C. C.), 132 F. 758.”

Angelus Sanitary Can Mach. Co. v. Wilson, 7 F. (2d) 314 (C. C. A. 9).

“As already suggested, the patent in suit is for a combination and neither party rests any argument upon the difference in type of the two valves employed. Both valves are common and well-known forms of check valves, and as was said by the court below, ‘open by gravity in the direction of the flow of the fuel. They perform the same function in substantially the same way, and accomplish the same result, and therefore in the sense of the patent law are the same thing.’ While Jay’s invention cannot be accorded a broad scope, it constituted a distinct advance in the art, entitling him to a reasonable range of equivalents. ‘Where a combination patent makes a distinct advance in the art to which it relates, as does the appellant’s invention here, the term “mechanical equivalent” should have a reasonably broad and generous interpretation.’ *Smith Cannery Mach. Co. v. Seattle-Astoria Iron Works* (C. C. A.), 261 F. 85. ‘We have repeatedly held that a charge of infringement is sometimes made out, though the letter of the claims be avoided.’ *Westinghouse v. Boyden Power-Brake Co.*, 170 U. S. 537, 568, 18 S. Ct. 707, 722 (42 L. Ed. 1136). See also *Hoyt v. Horne*, 145 U. S. 302, 308, 12 S. Ct. 922, 36 L. Ed. 713; *Kings County Raisin & Fruit Co. v. U. S. Consol. Seeding Raisin Co.* (C. C. A.), 182 F. 59; *Los Angeles Co. v. Nye* (C. C. A.), 270 F. 155; *Metallic Extraction Co. v. Brown* (C. C. A.), 104 F. 345.”

Jay et al. v. Suetter et al., 32 F. (2d) 879 (C. C. A. 9).

**RE GRAYSON PATENT 1,957,774 (R. 640) CLAIM 10
IN SUIT.**

Validity.

Appellee's brief, p. 34, states that it will rely upon the District Court's opinion holding the claim invalid over the art without further comment.

The prior art relied upon by the Court having been discussed in appellant's main brief, pp. 38-42, nothing further need be added.

Infringement.

Appellee states that it will rely upon the Master's finding that claim 10 is not infringed.

Although the Master's holding of non-infringement was overruled by the District Court, the question of infringement will be here discussed.

On the chart, Ex. 27, a graphic comparison is made between the elements recited in claim 10 of the second Grayson patent and defendant's thermostat. Reference to this chart will show that defendant's structure embodies structurally and functionally every element of the combination defined by claim 10 and operating in the same manner to produce the same result. Structurally and functionally claim 10 finds full response in defendant's structure. Literally, however, one element of claim 10 fails to read verbatim upon defendant's structure because defendant while accomplishing the identical result of the patented structure and in practically the same manner, employs a lever of a different type from that disclosed in the Grayson second patent for amplifying and transmitting to the valve the motion imparted by the clicker disk. This lever, which is element 6 of the claim, is defined in the claim as follows:

“A movement amplifying lever pivotally supported at one end and arranged to have movement communicated thereto intermediate its ends by the snap-action element, said lever having its free end arranged to communicate movement to the valve.”

The lever thus defined as “pivotally supported at one end” is a lever of the type commonly known in mechanics as a lever of the third order.

As this Court well knows, mechanical levers are of three orders or types. A lever of the first order has its fulcrum or pivot at one end, the power is applied at the other end and the load is disposed between the ends. A wheelbarrow, for instance, constitutes a lever of the first order.

A lever of the second order is pivoted or fulcrumed intermediate its ends, the power is applied at one end and the load is disposed at the other end. A crowbar when used for prying purposes is a lever of the second order. Defendant's lever fulcrumed between its ends is a lever of this second order.

A lever of the third order is fulcrumed or pivoted at one end, the power is applied intermediate its ends and the load is disposed at the other end. A fish-pole as commonly used constitutes a lever of the third order. Plaintiff's lever 54 in the second Grayson patent is a lever of the third order.

These three orders of levers are as old as mechanics. They are illustrated in every mechanical dictionary and are commonly known to be equivalents one for the other.

At the trial before the Master, plaintiff's expert Mr. Fishleigh characterized defendant's lever of the second order as “a perfectly clear schoolboy mechanical equivalent” of plaintiff's lever of the third order (R. 276). Defendant did not deny that equivalency.

The courts have repeatedly held that levers of different orders are purely mechanical equivalents. The following cases are typical:

Star Can Opener Co. v. Owen Dyneto Co., 16 Fed. (2d) 353 (C. C. A. 2d).

Hoeltke v. Kemp, 80 Fed. (2d) 912 (C. C. A. 4th).
Certiorari denied, 298 U. S. 673.

The Master held, incorrectly we believe, that defendant's lever of the second order is not the mechanical equivalent of the Grayson lever of the third order included in claim 10 (R. 43).

Judge Jenney, however, in sustaining plaintiff's objection to the Master's finding of non-infringement of this claim, said:

"The conclusion of the Court is that the specification of the form of the lever in claim 10 does not prevent the application of the doctrine of equivalents to that element." (R. 69.)

We submit that Judge Jenney's ruling on this point is correct, and his holding of infringement of claim 10 should be sustained by this Court.

Conclusion.

The District Court's indications in its opinion and findings that claims 20 and 22 of patent 1,699,468 are valid over the art and that these claims, as well as claim 10 of patent 1,957,774, have been infringed are supported by the record and should be approved.

The decree holding claims 20 and 22 of patent 1,699,468 invalid on the ground of new matter and lack of supplemental oath, and claim 10 of patent 1,957,774 invalid over the prior art, is not justified by the record and should be reversed.

Respectfully submitted,

ERROL O. SHOUR,

IRA J. WILSON,

Attorneys for Appellant.

